

REMARKS:Claims 1, 3, 4, 9, 10-13, 18-22, 27, 38 and 40

Claims 1, 3, 4, 9, 10-13, 18-22, 27, 38 and 40 have been rejected under 35 USC 102(b) as being anticipated by Firepad FireViewer Suite User's Guide (Firepad).

Claim 1 was previously amended to require output of previews of the display screen showing how the content will appear on the display screen of the wireless device. Support for this amendment is found in FIGS. 6 and 7 and related description of the present invention. This allows the user to see how the content will be ultimately displayed on the wireless device, thereby allowing the user to add or remove content to suit the user's particular preferences or requirements prior to actually viewing that content on the device.

In the "Response to Arguments" section, the Examiner indicates that Firepad teaches entering a graphic image file name for output on a device. It appears that the argument is that by virtue of FireConverter (PC side) showing the text as the user types it, the text appearing on the data entry screen is the preview, because the same text will be output if the user looks for the file name in FireViewer (device side).

To clarify Applicants' argument, claim 1 has been amended to require that the preview include both graphical and textual content simultaneously. The preview further shows how the simultaneously-displayed textual and graphical content will appear on the display screen of the wireless device relative to each other.

In sharp contrast, FireConverter only discloses outputting a preview of an image as it will be displayed on the wireless device. See the figure on p. 12 of Firepad. While this may be useful to determine whether the image will fit on the screen, it does not assist the user with how the remaining content will be displayed. Nor does the preview pane show how the text will appear relative to the graphic. In fact, the graphic and the file name might not even appear on the same screen of the device. Firepad does not say that it will. Accordingly, the preview pane of Firepad shown on p. 12 does not show a preview of a display screen of a wireless device where both textual and graphical output

are shown, and their positions relative to each other, as they will appear on the display of a wireless device, as now required by claim 1.

Accordingly, allowance of claim 1 and its dependents (2-9) is respectfully requested.

Claim 3 has been amended to require that the graphic is imported directly from a data source for output on the wireless device at a user-designated position relative to other content when output on the display screen of the wireless device. In other words, the user has designates the position of the graphic relative to other content. Support for this amendment is found on p. 14, lines 13-29 and FIGS. 19-22. In sharp contrast, Firepad does not allow the user to designate position of a graphics file relative to other content as displayed on a wireless device.

Claims 10 and 19 have been amended in a manner similar to claim 1, and are believed to be allowable for the same reasons set forth above. Allowance of claims 10-13, 18, 20-22 and 27 is respectfully requested.

Claim 38 as been amended in a manner similar to claim 1 and are believed to be allowable for the same reasons set forth above. Allowance of claim 38 is respectfully requested.

Claim 40 has been amended to require that the user be allowed to spatially organize the content as it will be spatially organized on the wireless device. In contrast, Firepad does not allow such spatial organization.

Claim 40 further requires that the user be allowed to create a link to content, where selection of the link downloads additional content from a remote data source. In contrast, Firepad only provides web archive support. See Firepad p. 15-16. As noted there, web pages are prepared for storage on the device itself and must be stored on the device prior to selection of the link. In contrast, the claimed invention does not download the content to the wireless device until the link is selected. This provides two advantages. One, downloading the content after selection of the link requires less storage on the device. Second, if the content pointed to by the link changes, the user will get the latest information as the content is then downloaded.

Firepad further fails to teach or suggest the claimed feature of allowing access to a web search service from the wireless device. Support for this limitation is found on p. 18, line 29 to p. 19, line 26.

Claim 40 further requires that the content be downloaded to the device via a wireless link. In contrast, Firepad requires either a physical connection for synchronization (hotsync), or placing the content on a media card for transfer to the device. See pp. 6 and 30 of Firepad. Thus, it cannot be said that, at the time of Applicants' invention, Firepad taught or suggested wireless download of content to the wireless device.

Thus, Firepad does not teach or suggest each and every claim limitation of claim 40, particularly as amended. Accordingly, reconsideration and allowance of claim 40 is respectfully requested.

Claims 2, 7, 16, 25, 28, 29, 32, 34-37 and 39

Claims 2, 7, 16, 25, 28, 29, 32, 34-37 and 39 have been rejected under 35 USC 103(a) as being unpatentable over Firepad.

Claims 2 and 7 depend from claim 1, and therefore are also believed to be allowable for the same reasons as claim 1.

The rejection of claim 2 relies on official notice. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697.

Claim 2 has further been amended to require that the user be allowed to define at least some of the content associated with each view. Applicants submit that, at the time the present invention was made, such user-definable portals were not notorious and well known in the context of wireless devices, and perhaps even nonexistent absent Applicants' disclosure. Accordingly, claim 2 is distinguishable from Firepad, and the Official Notice does not apply to the limitations of claim 2. If a future rejection of claim 2 relies on Official Notice, Applicants request a specific showing of a portal in the context of wireless device enablement, and having each and every claimed feature, and further that predates Applicants' date of invention.

Claim 16 depends from claim 10, and therefore is also believed to be allowable for the same reasons as claim 10.

Claim 25 depends from claim 19, and therefore is also believed to be allowable for the same reasons as claim 19.

Claim 28 has been amended in a manner similar to claim 40, and is believed to be allowable over Firepad for the same reasons set forth above. Allowance of claims 28, 29, 32, 34 and 35 is respectfully requested.

Regarding claims 36 and 37, Applicants respectfully disagree that claim 36 is obvious over Firepad.

The analysis of obviousness was set forth in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). In order to establish a *prima facie* case of obviousness, three basic criteria must be met:

First, there must be some *suggestion or motivation*, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings of the references. Second, there must be a *reasonable expectation of success*. Finally, the prior art reference or combined references must teach or suggest *all the claim limitations*. *The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art*, and not based on applicant's disclosure (*In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991; emphasis added).

Applicants respectfully disagree with assertion that it would have been obvious to modify the teachings of Firepad to anticipate claims 36 and 37. Specifically, the modification proposed by the Examiner fails the first element of the *Graham* test.

Regarding the first prong of the *Graham* test, a statement that modifications of the prior art to meet the claimed invention would have been “ ‘well within the ordinary skill of the art at the time the claimed invention was made’ ” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

In the instant case, the rejection merely indicates that it would have been obvious to one skilled in the art to add a navigation tree, such as that found in Microsoft Windows Explorer, to Firepad in order to meet the claimed limitations. Applicants respectfully disagree. Nowhere does Firepad itself suggest addition of a navigation tree for such things as allowing linking from one window in one view to another window in another view. Rather, the rejection relies on features purportedly “notoriously well known in the art.” Accordingly, it cannot be said that Firepad itself suggests the proposed modification or addition of features from other software such as Microsoft Windows.

Nor has the Examiner provided a reasonable motivation based on knowledge generally available to those skilled in the art and not provided by Applicants in the present disclosure.

“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd.Pat.App.&Inter.1985).

Nowhere does the rejection provide a motivation to add such a navigation tree to Firepad. In fact, the rejection indicates that the tab method of Firepad "performs the same functions as that of the claimed navigation tree." If the Firepad tab method is truly equivalent to the navigation tree as suggested in the rejection, why would one skilled in the art be motivated to add the navigation tree to Firepad if they "perform equally as well"? The functionality would already be there. Thus, the only conclusion that can be drawn is that the combination of art proposed by the Examiner has been drawn from Applicants' disclosure.

Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). As noted in the rejection, the Firepad tab method is fully functional and "performs equally as well" as the navigation tree, so it cannot be said that Firepad suggests modification of itself to include a navigation tree.

Because the *Graham* test is not met, allowance of claims 36 and 37 is respectfully requested.

Claim 39 depends from claim 38, and therefore is also believed to be allowable for the same reasons as claim 38.

Claims 5, 6, 8, 14, 15, 17, 23, 24, 26, 30, 31, 33

Claims 5, 6, 8, 14, 15, 17, 23, 24, 26, 30, 31 and 33 have been rejected under 35 USC 103(a) as being unpatentable over Firepad in view of Shinbori (US4661000).

Applicants traverse the rejection based on Firepad and Shinbori because Shinbori is nonanalogous art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Taking the first element, Shinbori is not in the field of Applicants' endeavor, managing content for output on wireless devices. Rather, Shinbori describes a layout display device of an electronic printer. See Shinbori col. 1, line 63 to col. 2, line 19. As shown in Shinbori FIGS. 11(b), 12(b), 13(b) and 14(b), no text is actually displayed in Shinbori's layout display. Rather, "dots" are used to indicate a character and line layout of a page to be printed. See col. 9, lines 41-56. Thus, on its face, Shinbori is most definitely not in the field of managing content for output on wireless devices.

Considering the second element, Shinbori is not reasonably pertinent to the particular problem with which the inventors were concerned. Shinbori automatically formats textual content so that all of the display segments in a printer layout display are used. See Shinbori col. 1, lines 60-62. As shown in Shinbori FIGS. 11(b), 12(b), 13(b) and 14(b), no text is actually displayed in Shinbori's layout display. Rather, dots are used to indicate a character and line layout on a page to be printed. See col. 9, lines 41-56. Therefore, because Shinbori does not pertain to display of text but rather "dots" used to show how a page will be printed, Shinbori is not relevant to the problem with which the inventors were concerned, namely that of allowing configuration of how text is displayed.

Accordingly, Shinbori is believed to be disqualified as a prior art reference.

Allowance of claims 5, 6, 8, 14, 15, 17, 23, 24, 26, 30, 31 and 33 is respectfully requested.

Claims 41-44

Claims 41-44 have been rejected under 35 USC 103(a) as being unpatentable over Firepad in view of Maes (US6016476).

Claims 41-42 are dependent upon claim 40. Because claim 40 is believed to be allowable over Firepad, and because Maes has simply been added to show use of a text-to-speech converter, claims 41-42 are believed to be allowable over the proposed combination of references. Allowance of claims 41-42 is respectfully requested.

Claims 43-44 are dependent upon claim 1. Because claim 1 is believed to be allowable over Firepad, and because Maes has simply been added to show use of a text-to-speech converter, claims 43-44 are believed to be allowable over the proposed combination of references. Allowance of claims 43-44 is respectfully requested.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. For payment of any additional fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. NVIDP376/P002188).

Respectfully submitted,

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